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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,564	12/17/2001	Takaaki Kutsuna	011709	6229

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EXAMINER

SELLERS, ROBERT E

ART UNIT PAPER NUMBER

1712

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/015,564

Applicant(s)

KUTSUNA ET AL.

Examiner

Robert Sellers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 26, 28 and 30-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26, 28, 30 and 48-58 is/are allowed.
- 6) ☒ Claim(s) 31-33 and 38-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

1. The suggested modifications to claims 31 and 34 on page 2, paragraph 2 of the non-Final rejection mailed August 2, 2004 have been adopted in the amendment filed November 2, 2006.
2. Claims 26, 28 and 30 (inadvertently omitted) were previously deemed to be allowable in the non-Final rejection (page 5, paragraph 6). The terminal disclaimers for copending application no. 10/516,956 and U.S. Patent No. 6,861,147 filed November 2, 2006 along with that filed March 11, 2005 with respect to copending application no. 10/488,684 overcomes the obviousness-type double patenting rejections. Accordingly, claims 34-37 and 48-58 are deemed to be allowable.
3. The molar ratios of polyfunctional compound (B) to meta- or para-xylylenediamine (A) of from 0.3 to 0.95 set forth on page 16, lines 5, 6 and 9 as well as claims 31 and 38 would be more concisely denoted as from 0.3:1 and 0.95:1 since the molar ratio could be misinterpreted as 0.3:0.95.

The text of section 103(a) of Title 35, U.S. Code not included in this action can be found in the non-Final rejection.

Claims 31-33 and 38-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Nos. 8-104738 and 63-301264 in view of Carlblom et al. Patent No. 5,728,439 and Huang et al. Patent No. 3,683,044.

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Japanese Patent No. 47-30640 is no longer relied upon since the newly claimed molar ratio of polyfunctional compound (B) to xylylenediamine of from 0.3:1 to 0.95:1 is less than the reaction of more than 1 mole of acrylate with 1 mole of xylylenediamine.

Great Britain Patent No. 2,221,388 is withdrawn since independent claims 31 and 38 limited to particular species of acyl group(s)-containing polyfunctional compound (B) precludes the types of dicarboxylic acids set forth on page 1, lines 57-59.

Otherwise, the rejection is maintained for the reasons of record set forth in the non-Final rejection.

4. Japanese '739 (translation, page 5, paragraph 30, shows Amine F derived from meta-xylylenediamine and methyl methacrylate which is the closest prior art curing agent encompassed by claimed reaction product of meta-xylylenediamine (A) and a methacrylic acid derivative (B). The declaration filed November 2, 2006 attempts to compare Example 3 (specification, page 37) containing 33 parts by weight (pages 36-37) of amine curing agent A prepared from meta-xylylenediamine and methyl acrylate (pages 29-30) and 50 parts by weight of the tetraglycidyl ether of meta-xylylenediamine TETRAD-X, with a Comparative Example 9 wherein octadecylamine is mixed with amine curing agent C of Japanese '739 (the reaction product of meta-xylylenediamine and dimer acid).

5. The comparison is inconclusive since the closest prior art example of Japanese '739 is not the curing agent derived from a dimer acid, but that produced from methyl methacrylate. Even if the comparison is considered, the use of different relative amounts of curing agent, the mixing of curing agent C with octadecylamine not described in Japanese '738, and the lack of commensurateness of the evidence with the claims which embrace myriad other species of polyfunctional compound (B) seriously compromises any conclusions as to the criticality of polyfunctional compound (B).

6. The "consisting essentially of" language used to confine the amine curing agent and its reactants in claims 31 and 38 merely "limits the scope of a claim to the specified materials . . . 'and those that do not materially affect the basic and novel characteristic(s)' of the claimed invention. *In re Herz*, 537 F.2d. 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original)." The polyamideamine of Japanese '264 would not materially affect the basic and novel characteristics of the claimed composition since the claimed curing agent obtained from polyfunctional compounds (B) with carboxyl groups and the xylylenediamine yield reaction products containing amide groups equivalent to those emanating from the polyamideamine of Japanese '264. No distinction with respect to any characteristics is seen between the polyamideamine of Japanese '264 together with the xylylenediamine-acrylic compound adduct as a thick film and the claimed xylylenediamine-polyfunctional compound reaction product which also possesses amide moieties.


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The amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers  
Primary Examiner  
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